



PATENT
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USSN 09/858,318

UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : KELLOGG et al.
Serial No. : 09/858,318
Filing Date : May 15, 2001
For : Microfluidics Devices For High Throughput Screening
Examiner : Latoya Cross
Art Unit : 1743

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**PRELIMINARY AMENDMENT UNDER 37 C.F.R. § 1.114(c) WITH FEE
TRANSMITTAL, PETITION TO EXTEND TIME AND
STATEMENT OF COMMON OWNERSHIP AND REQUEST FOR INTERVIEW**

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

It is respectfully requested that prior to continues examination, the following amendments be entered without prejudice, without admission, without surrender of subject matter, and without any intention of creating any estoppel as to equivalents, and that there be an interview, prior to the issuance of any First Office Action.

FEE TRANSMITTAL UNDER 37 C.F.R. §§ 1.16(h) and 1.16(i)

Pursuant to 37 C.F.R. §§ 1.16(h) and 1.16(i), two additional independent claims in excess of three have been added and four additional dependent claims have been added. Payment for the additional independent claims and dependent claims (\$600.00) is enclosed. The Commissioner is authorized to charge any additional fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

STATEMENT OF COMMON OWNERSHIP

Please accept this statement of common ownership which asserts that Tecan Trading AG is the common owner of U.S. Patent No. 6,582,662 (“the ‘662 patent”), U.S. Patent No. 6,063,589 (“the ‘589 patent”) and application Serial No.: 09/858,318 (“the ‘318 application”).

The Office Action dated September 12, 2005 included a rejection of claims 1-7, 9-24, and 32-41 which utilized the ‘662 patent and the ‘589 patent. While it is not agreed that obviousness has been established by the Examiner for the abovementioned claims, these rejections would be rendered moot if the ‘662 patent and the ‘589 patent were ineligible for use as prior art.

Pursuant to 35 U.S.C. § 103(c), MPEP 706.02(l)(1) and MPEP 706.02(l)(2), the burden resides with the applicants to show that the ‘662 patent, the ‘589 patent and the ‘318 application were commonly owned at the time the claimed invention was made or subject to an obligation of assignment that would establish common ownership.

When the ‘318 application was filed May 15, 2001, the ‘318 application, the application of the ‘662 patent (U.S. patent application serial no. 09/595,239, “the ‘239 application”) listed Gregory J. Kellogg and David C. Duffy as inventors and the application of the ‘589 patent (U.S. patent application 09/083,678, “the 678 application”) listed Gregory Kellogg, Stephen G Keiffer-Higgins, Bruce L Carvalho, Gene A. Davis and John P. Willis, Ted Minior, Laura L. Chapman, Mikayla Kob, Sarah D. Oeltjen, Shari Ommert and Alec Mian as inventors and all three applications had assigned or were obligated to assign their respective inventions to Tecan Trading AG¹ at the time the invention was made. The assignment of the ‘239 application was recorded on April 15, 2003 on Reel 013953/Frame 0573. The assignment of the ‘678 application was recorded on October 19, 1998 on Reel 009544/Frame 0385. The assignment of the ‘318 application was recorded on January 9, 2002 on Reel 012456/Frame 0509. Therefore, the appellants believe that common ownership has been established and as such U.S. Patent No. 6,582,662 and U.S. Patent No. 6,063,589 are disqualified as prior art.

¹ The inventors of the ‘589 patent had assigned or were obligated to assign their invention to Gamera Bioscience at the time the invention was made. Tecan acquired Gamera Bioscience Corporation in 2000. See, e.g., copy of press release attached hereto as Exhibit A.